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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,772	05/26/2005	Jianren Gu	186691/US	4584

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MINNEAPOLIS, MN 55402-0902

EXAMINER

REDDIG, PETER J

ART UNIT	PAPER NUMBER
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1642

MAIL DATE	DELIVERY MODE
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10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/536,772

Applicant(s)

GU ET AL.

Examiner

Peter J. Reddig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed July 17, 2007 in response to the Office Action of April 17, 2007 is acknowledged and has been entered. Previously pending claims 2-10 have been cancelled, claim 1 has been amended, and new claims 11 and 12, drawn to the subject matter of a previously not elected invention have been added.

2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11 and 12 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. 1.142(b) and M.P.E.P. 821.03.

3. Claim 1 is currently under consideration.

4. The following rejections/objections are being maintained:

Specification

5. Applicants argue that the specification is objected to for improper disclosure of amino acid sequences without respective sequence identifiers. To comply with 37 CFR § 1.821-1.825, Applicants respectfully submit a computer readable form (CRF) of the sequence listing, a substitute paper copy of the sequence listing, as well as an amendment directing its entry into the specification and a statement as required. The substitute sequence listing has been mailed to Mailstop Sequence along with a copy of the Notice to Comply, as required by the Office Action. With further particularity, SEQ ID NOs: 14-18 have been added to the sequence listing, which respectively correspond to sequences for CT120, CT120B, CT 120-like, mCT120-like 1 and mCT120-like 2, and which are provided in Applicants' specification, for example at page 15, lines 28-33 and in Figure 1. Applicants respectfully submit that the specification is in proper form.

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Applicants' arguments have been carefully considered, but have not been found persuasive because the compact disk containing the sequences is defective as stated in the notice mailed August 8, 2007. Additionally, reference to the SEQ ID NO: numbers needs to be added to the brief description of Figure 1.

Priority

6. Applicants argue that this Application enjoys the benefit of priority having the date November 27, 2002 for the reasons herein. As suggested by the Examiner, Applicants enclose herewith the English translations of the priority documents PCT/CN03/00845 and CN02150730.9. Applicants respectfully submit that the English translation of the international application PCT/CN03/00845 corresponds to the present application as filed on May 25, 2005. Thus, Applicants believe that this translation should be identical with the present application. As to the English translation of CN02150730.9, Applicants respectfully submit the translation is substantially identical to PCT/CN03/00845, where both priority applications include the subject matter disclosed and claimed in the present application. In fact, the subject matter claimed is supported throughout the disclosures of these priority documents. For example, the drawings of PCT/CN03/00845 and CN02150730.9, which also are the same as that of the present application, disclose the features claimed. For at least these reasons, Applicants believe that they are entitled to enjoy the benefit of priority of PCT/CN03/00845 as well as CN02150730.9, which was filed on November 27, 2002.

Applicants' arguments have been carefully considered and have been found persuasive in part. The priority date will be reset to October 8, 2003 based on the filing date of the international application PCT/CN03/00845. However, in regard to the translation of

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CN02150730.9, a translation must be filed together with a statement that the translation of the certified copy is accurate, see MPEP 201.15, and no such statement is present. Submission of a statement that the translation of the certified copy is accurate would obviate this objection.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 remains rejected under 35 USC 102(b) as being anticipated by He et al. (Biochem. Biophys. Res. Com., September 27, 2002, 297:528-536, IDS) for the reasons previously set forth in section 11, pages 18-19 of the Office Action of April 17, 2007.

Applicants argue that He et al. does not constitute prior art as alleged in the Office Action, because the present application is entitled to enjoy the priority of CN 02150730.9, which was filed on November 27, 2002.

Applicants' arguments have been carefully considered, but have not been found persuasive because, as set forth above, the priority is currently October 8, 2003 for the instantly claimed invention. It is noted that even if Applicants were granted priority to the foreign application, CN02150730.9, the application would remain rejected under 35 USC 102(b). The right to rely on the foreign filing extends to overcoming the effects of intervening references or uses, but there are certain restrictions. For example, the 1 year bar of 35 U.S.C. 102(b) dates from the U.S. filing date and not from the foreign filing date; thus if an invention was described in a printed publication, or was in public use in this country, in November 1981, a foreign application filed in January 1982, and a U.S. application filed in December 1982, granting a patent on the U.S. application is barred by the printed publication or public use occurring more than one year prior to its actual filing in the United States, see MPEP 201.13 (III).

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claim 1 remains rejected under 35 USC 102, now 35 USC 102(a), in view of the change in priority date, as being anticipated by He et al. (Chinese Journal of Cancer, February, 2003, 22:113-8) for the reasons previously set forth in section 12, pages 19-20 of the Office Action of April 17, 2007.

Applicants argue that He et al. does not constitute prior art as alleged in the Office Action, because the present application is entitled to enjoy the priority of CN 02150730.9, which was filed on November 27, 2002.

Applicants' arguments have been carefully considered, but have not been found persuasive because, as set forth above, the priority is currently October 8, 2003 for the instantly claimed invention. Submission of a statement that the translation of the certified copy of CN 02150730.9 is accurate would obviate this rejection.

Applicant's arguments have not been found persuasive and the rejection is maintained.

9. All other objections and rejections recited in the Office Action of April 17, 2007 are withdrawn.

10. No claims allowed.

11. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee.

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If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal form, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R., 1.136(a).

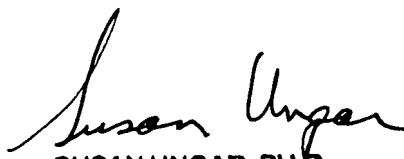
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R., 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Reddig whose telephone number is (571) 272-9031. The examiner can normally be reached on M-F 8:30 a.m.-5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on (571) 272-0890. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SUSAN UNGAR, PH.D
PRIMARY EXAMINER

Peter J. Reddig
Examiner
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PJR